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GREGORY A. STOBBS
5445 CORPORATE DRIVE
SUITE 400
TROY, MI 48098

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OFFICE OF PETITIONS

In re Patent No. 7,542,834 :
Nobori, et al. : DECISION ON
Application No. 10/540,135 : REQUEST FOR
Issue Date: June 2, 2009 : RECONSIDERATION OF
Filed: June 21, 2005 : PATENT TERM ADJUSTMENT
Attorney Docket No. :
5077-244/NP :

This is in response to the PETITION UNDER RULE 1.705, filed July 29, 2009, which is properly treated under 37 CFR 1.705(d). Patentees request that the determination of patent term adjustment be corrected from five hundred thirty-three (533) days to nine hundred twenty-six (926) days.

The request for reconsideration of patent term adjustment is DISMISSED with respect to making any change in the patent term adjustment determination under 35 U.S.C. § 154(b) of 533 days.

On June 2, 2009, the application matured into U.S. Patent No. 7,542,834, with a revised patent term adjustment of 533 days. The Office determined that the 346 days of Office delay pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b)^{1,2} overlaps with the 584 days of Office delay pursuant to 35 U.S.C. 154(b)(1)(A)

¹ Pursuant to 35 U.S.C. 154(b)(1)(B), 37 CFR 1.702(b) provides, in pertinent part, that:

Failure to issue a patent within three years of the actual filing date of the application. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application

² The application was pending three years and 346 days.

and 37 CFR 1.702(a)(1)^{3,4} accorded prior to the issuance of the patent. As such, the Office allowed only entry of the adjustment of 584 days. No additional days of patent term adjustment were entered at issuance under the three-year pendency provision. Given the applicant delay of 51 days, the patent issued with a revised patent term adjustment of 533 (584 - 51) days.

On July 29, 2009, patentees timely submitted this request for reconsideration of patent term adjustment within two months of the issue date of the patent. See 37 CFR 1.705(d). Patentees aver that the correct number of days of patent term adjustment is 926 days based, in part, on the court's interpretation of the overlap provision as set forth in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q.2d 1538 (D.D.C. 2008). Specifically, patentees state that:

...Applicant hereby petitions under Rule 1.705 for a corrected Patent Term Adjustment of an additional 344 days since the present Patent did not issue within 36 months of the filing date, namely by June 21, 2008. The 2 days attributable to Applicant's delay have been subtracted from the computation.

In addition to the 344 days sought under Wyeth, Applicant further petitions for a corrected Patent Term Adjustment of an additional 49 days since 49 days were mistakenly counted as Applicant delay upon Applicant's

³ 37 CFR § 1.702, provides grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application;

⁴ A first Office action was not mailed until March 27, 2008, fourteen months and 584 days after the date of completion of all 35 U.S.C. 371 requirements on June 21, 2005.

filing of an amendment on January 23, 2009. Applicant's Amendment was filed in response to a revised Office Action mailed October 23, 2009 restarting the period for response to the previous Office Action. The revised Office Action was issued due to a deficiency in the previous Office action (mailed September 5, 2008) which should not cost Applicant days under the Patent Term Adjustment calculation.

Therefore, adding the 344 days earned by the holding in *Wyeth* and the 49 days incorrectly reduced for the response to the revised Office Action, Applicant petitions for a corrected Patent Term Adjustment totaling 393 days. The corrected Patent Term Adjustment should now equal 926 days.

Excerpt taken from "Petition under Rule 1.705", filed July 29, 2009, pgs. 1-2.

No consideration will be given to patentees' assertion that the 49 day reduction to the patent term adjustment was not warranted because the assertion is untimely. Further to this point, PALM records indicate that the issue fee payment was received in the Office on April 23, 2009. No filing of an application for patent term adjustment preceded the payment of the issue fee. The period for filing an application for patent term adjustment requesting reconsideration of the initial determination of patent term adjustment at the time of mailing of the notice of allowance ended February 24, 2009. Accordingly, relative to the 49 days of reduction to the patent term adjustment entered prior to the issuance of the patent, it is appropriate to dismiss this petition as untimely filed under § 1.705(b).

Further, consideration under § 1.705(d) is not appropriate. As stated in MPEP 2730, § 1.703(d) provides that:

If there is a revision to the patent term adjustment indicated in the notice of allowance, the patent will indicate the revised patent term adjustment. If the patent indicates or should have indicated a revised patent term adjustment, any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued and must comply with the requirements of paragraphs (b)(1) and

(b) (2) of this section. Any request for reconsideration under this section that raises issues that were raised, or could have been raised, in an application for patent term adjustment under paragraph (b) of this section shall be dismissed as untimely as to those issues.

The issue of the 49 day reduction to the patent term adjustment raised herein should have been timely raised on application for patent term adjustment under § 1.705(b). Thus, the 49 days of reduction to the patent term adjustment will not be removed.

The Office notes that period of delay of 344 days, pursuant to 37 CFR 1.702(b), as set forth by patentees, for the Office taking in excess of three years to issue the patent is incorrect as patentees did not use the 35 U.S.C. 371(b) national stage commencement date of June 21, 2005, in calculating the period of adjustment under 37 CFR 1.703(b). As stated in 37 CFR 1.703(b), the period of adjustment under § 1.702(b) is the number of days in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) in an international application and ending on the date a patent was issued. Pursuant to 37 CFR 1.703(b), the period of adjustment under 37 CFR 1.702(b) should be 346 days, counting the number of days beginning on the day after the date that is three years after the date on which the national stage commenced under 35 U.S.C. 371(f), June 22, 2008, and ending on the date the patent issued, June 2, 2009.

The Office has considered patentees' interpretation of the period of overlap, but finds it inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. 154(b)(2)(A). 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f)*⁵ and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A), 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the

⁵ Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in § 1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding 37 CFR 1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period from June 21, 2005, the date of commencement of the national stage under 35 U.S.C. 371(f), to June 2, 2009, the date of the issuance of the patent (not including any other periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)).

Pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1), 584 days of patent term adjustment were accorded for Office delay prior to the issuance of the patent. Pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b), 346 days of patent term adjustment accrued for Office issuance of the patent more than three years after the date of commencement of the national stage under 35 U.S.C. 371(f). All of the 346 days of patent term adjustment under 37 CFR 1.702(b) overlap with the 584 days of patent term adjustment under 37 CFR 1.702(a)(1). Entry of both the 584 days and the 346 days is neither permitted nor warranted. 584 days is the actual number of days issuance of the patent was delayed.

Accordingly, at issuance, the Office properly entered no additional days of patent term adjustment.

In view thereof, the Office affirms that the revised determination of patent term adjustment at the time of the issuance of the patent is 533 days (584 days of Office delay - 51 days of applicant delay).

The Office acknowledges the submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The address cited on the petition differs from the address of record. A courtesy copy of this decision is being mailed to the address cited on the petition. All future correspondence will be mailed to the correspondence address of record until appropriate written instructions to the contrary are received.

Telephone inquiries specific to this matter should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

cc:
Harness, Dickey & Pierce, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303